Alpha Home Appliance Sdn Bhd v NSB Home Appliance & Anor

HIGH COURT (KUALA LUMPUR) — CIVIL SUIT NO 22IP-32–9 OF 2013
AZIZAH NAWAWI J
10 DECEMBER 2015

Patents — Industrial designs — Registered design — Plaintiff sued defendants for infringing its registered industrial design of ceiling fan housing — Whether features in defendants' ceiling fans were obvious imitation of plaintiff's registered design — Whether defendants failed in counterclaim to revoke registration of plaintiff's design on ground it was not novel — Whether evidence relied upon to prove counterclaim inadmissible for non-compliance with Evidence Act 1950 or for being hearsay or mere opinion of witnesses or for falling outside defendants' pleaded case

The plaintiff sought, inter alia, injunctive reliefs, orders for delivery up and damages against the defendants for infringing its registered industrial design ('the plaintiff's ID') of its 'Alpha' ceiling fan housing. The claim was premised on s 32 of the Industrial Designs Act 1996 ('the IDA'). In response, the defendants counterclaimed that the plaintiff's ID should be revoked under s 27(1)(a) of the IDA on the ground the industrial design was not novel and should not have been registered on 10 September 2007 as it had been disclosed to the public by way of advertisement prior to that date. Since August 2008, the plaintiff had been making, distributing and selling the Alpha Fan with its distinctive round-shaped housing. In early 2013, it discovered that the first defendant was distributing and selling fans, under the brand 'ASTA 56', whose housing features were identical to that of the Alpha Fan. The defendants sought to rely on various documents and witnesses to prove that the plaintiff's industrial design was not novel at the time of its registration but the plaintiff countered by saying the documents/witness testimony relied upon by the defendants were inadmissible for non-compliance with the Evidence Act 1950 or were hearsay or mere opinion or sought to admit evidence of matters that were outside the defendants' pleaded case.

Held, allowing the claim and dismissing the counterclaim with costs:

(1) Having seen the actual Alpha Fan and the ASTA 56 and having looked at the designs of both fans as a whole, the court found that the shape, configuration, pattern and ornament of the defendants' ASTA 56 was an obvious imitation of the corresponding features of the Alpha Fan. Both fans were round in shape in respect of the bottom part of the housing and

the motor housing (covering the motor, metal arms which held the blades and the motor of the fan). The defendants submitted that although the ASTA 56 was round, it was concave at the bottom. But viewing it from a little distance away, the 'concave bottom' was neither noticeable nor distinctive enough to distinguish it from the plaintiff's Alpha Fan. The defendants also failed to rebut prima facie evidence that the plaintiff was the registered owner of the Alpha Fan industrial design (see paras 42, 52–53 & 55).

(2) The defendants failed to establish that the plaintiff's ID lacked novelty because it was published and/or sold before the registration date of the ID on 10 September 2007. The counterclaim on novelty was based on inadmissible evidence, hearsay evidence and mere opinions of witnesses. The defendants were also bound by their pleadings. As they had pleaded that the disclosure of the design to the public was by way of advertisement and not by way of sales in the market they could not adduce evidence of the latter to prove their counterclaim. There was no merit in the defendants' application to revoke the registration of the plaintiff's Alpha Fan (see paras 19–20, 35 & 38).

[Bahasa Malaysia summary

Plaintif memohon, antara lain, relief injunktif, perintah-perintah bagi menyerahkan dan ganti rugi terhadap defendan-defendan kerana melanggar seni reka perindustrian berdaftarnya ('SRP plaintif') terhadap 'Alpha' seni reka perindustrian bingkai kipas siling. Tuntutan berdasarkan s 32 Akta Seni Reka Perindustrian 1996 ('Akta'). Dalam jawapan, defendan-defendan menuntut balas bahawa SRP plaintif patut dibatalkan di bawah s 27(1)(a) Akta atas alasan seni reka perindustrian baru dan tidak patut didaftarkan pada 10 September 2007 kerana ia telah didedahkan kepada orang awam melalui iklan sebelum tarikh tersebut. Semenjak Ogos 2008, plaintif telah membuat, mengagihkan dan menjual kipas Alpha yang mempunyai bingkai berbentuk bulatnya yang tersendiri. Pada awal tahun 2013, ia mendapati bahawa defendan pertama mengagihkan dan menjual kipas, di bawah jenama 'ASTA 56', yang mana sifat bingkainya adalah sama kepada kipas Alpha. Defendan-defendan memohon untuk bergantung ke atas pelbagai dokumen dan saksi untuk membuktikan bahawa seni reka perindustrian plaintif bukan baru pada masa pendaftarannya tetapi plaintif menjawab dengan menyatakan bahawa dokumen-dokumen/keterangan saksi yang digunakan oleh defendan-defendan tidak boleh diterima kerana tidak patuh kepada Akta Keterangan 1950 atau adalah kata dengar atau hanya pendapat atau memohon untuk memasukkan keterangan perkara yang di luar kes diplidkan defendan-defendan.

Diputuskan, membenarkan tuntutan dan menolak tuntutan balas dengan kos:

(1) Setelah melihat kipas Alpha sebenar dan ASTA 56 dan setelah melihat kepada seni reka kedua-dua kipas keseluruhannya, mahkamah mendapati bahawa bentuk, tatarajah, corak dan perhiasan ASTA 56 defendan-defendan adalah jelas peniruan ciri-ciri yang sama terhadap kipas Alpha. Kedua-dua kipas adalah berbentuk bulat dari segi bahagian bawah bingkai dan bingkai motor (menutup motor, cabang-cabang logam yang memegang mata kipas dan motor kipas). Defendan-defendan berhujah bahawa walaupun ASTA 56 adalah berbentuk bulat, ia adalah cekung di bahagian bawah. Tetapi melihatnya daripada jarak jauh sedikit, 'concave bottom' adalah tidak ketara ataupun cukup tersendiri untuk membezakannya daripada kipas Alpha plaintif. Defendan-defendan juga gagal untuk mematahkan keterangan prima facie bahawa plaintif adalah pemilik berdaftar seni reka perindustrian kipas Alpha (lihta perenggan 42, 52–53 & 55).

(2) Defendan-defendan gagal untuk membuktikan bahawa SRP plaintif adalah bukan baru kerana ia telah didedahkan dan/atau dijual sebelumk tarikh pendaftaran SRP tersebut pada 10 September 2007. Tuntutan balas atas pembaharuan adalah berdasarkan keterangan tak boleh diterima, keterangan kata dengar dan hanya pendapat saksi-saksi. Defendan-defendan juga terikat dengan pliding mereka. Memandangkan mereka telah memplidkan bahawa pendedahan seni reka tersebut kepada orang awam adalah melalui iklan dan bukan melalui jualan di pasaran mereka tidak boleh mendedahkan keterangan mengenai yang kemudiannya untuk membuktikan tuntutan balas. Tidak terdapat merit dalam permohonan defendan-defendan untuk membatalkan pendaftaran kipas Alpha plaintif (lihat perenggan 19–20, 35 & 38).]

Notes

For cases on registered design, see 10(1) *Mallal's Digest* (5th Ed, 2015) paras 1263–1264.

Cases referred to

F&N Dairies (Malaysia) Sdn Bhd v Tropicana Products, Inc [2013] MLJU 159; [2013] 1 LNS 380, CA (refd)

KPM Khidmat Sdn Bhd v Tey Kim Suie [1994] 2 MLJ 627; [1994] 3 CLJ 1, SC (refd)

Magicboo Beauty Sdn Bhd v Koh Chui Ngoh [2013] 1 LNS 370, CA (refd)

Popular Industries Ltd v Eastern Garment Manufacturing Sdn Bhd [1989] 3 MLJ 360, HC (refd)

Three V Marketing Sdn Bhd v Heng Capital Industries (M) Sdn Bhd (The Registrar of Industrial Design, interested party) [2010] 2 MLJ 807, HC (folld)

Yew Wan Leong v Lai Kok Chye [1990] 2 MLJ 152; [1990] 1 CLJ 330, SC (refd)

Legislation referred to

Evidence Act 1950 ss 63, 65, 73A, 73A(1)(a), (1)(b)
Industrial Designs Act 1996 ss 3(1), 9(1), (3), 12, 12(2), (2)(a), 27, 27(1)(a), 32

Lee Kok Phong (M Scully) for the plaintiff.
Damian Yeo (Damian SL Yeo & LC Goh) for the defendants.

Azizah Nawawi J:

INTRODUCTION

[1] The plaintiff's claim against the defendants is premised on s 32 of the Industrial Designs Act 1996 ('the IDA 1996') for infringing the plaintiff Industrial Design Registration No MY07–1270–0306 ('the plaintiff's ID') and for passing off. The plaintiff therefore seeks injunctive reliefs, orders for delivery up and damages and/or at the plaintiff's option, an account of profit.

[2] In response, the defendants filed a counterclaim seeking to revoke the plaintiff's ID under s 27(1)(a) of the IDA 1996 on the basis that the 'round shape' Alpha Fan protected under the plaintiff's ID is not novel as there is disclosure by way of advertisement before the date of registration of the ID, 10 September 2007.

THE SALIENT FACTS

[3] The plaintiff is a company incorporated in Malaysia and deals with the research and development, manufacture and distribution of home appliances, in particular to fans and water heaters.

[4] The first defendant is a company incorporated in Malaysia and its business includes the manufacture, import, export and distribute all kinds of home appliances. The second defendant's nature of business is trading in electrical light fittings. From the company search, both the first and second defendants have common directors and share the same registered address in Jalan Cheras, Kuala Lumpur.

[5] On 10 September 2007, the plaintiff applied to register its Alpha Fan's Housing ('Alpha Fan Housing') with the Industrial Design Registration Office, MYIPO. The application was granted on 21 August 2008 and registered as MY07–01270–0309 dated 10 September 2007.

[6] The plaintiff's ID, the Alpha Fan Housing depicts feature of shape, configuration, pattern and ornament which are applied to a housing of fan.

The statement of novelty of the Alpha Fan Housing states that 'the novelty of the design for Industrial Design Registration MY07–01270–0309 resides in the shape and configuration of the articles as shown in the said solid lines in the representation'.

[7] Since 21 August 2008, the plaintiff has been manufacturing, distributing, offering for sale and/or selling the Alpha Fan with the Alpha Fan's Housing as per the registered industrial design MY07–01270–0309.

[8] The first defendant began selling the 'ASTA 56' fans since December 2012. The 'ASTA 56' fans were imported from China.

[9] The distribution of 'ASTA 56' by the first defendant was made through different retailers throughout Malaysia. It is part of the agreed facts between the parties that the 'defendan telah menjual, mengedar, menawar dan/atau membuat tawaran menjual kipas NSB model 'ASTA 56' (see agreed fact 5)'.

[10] Around January 2013, the plaintiff discovered that the first defendant has been distributing, offering for sale and selling fans, known as 'ASTA 56', with housing designed features of shape, configuration, pattern and ornament of which the plaintiff claims to be identical and/or obvious imitation of the Alpha Fans.

[11] The plaintiff filed this suit against the defendants for infringement and passing off. However, as can be seen from para 1.5 of the plaintiff's written submission, the plaintiff has limited its case to industrial design infringement and did not submit on the claim for passing off.

THE FINDINGS OF THE COURT

[12] Before I deal with the issue of infringement, I will first consider the defendants' counterclaim to revoke the plaintiff's ID, that is whether the plaintiff's ID as registered is valid. If this court finds that the ID is invalid, there is no longer any issue of infringement.

Issue of revocation

[13] The defendant's application for revocation is premised on s 27 of the IDA 1996 which reads:

> 27 Revocation of registration and grant of compulsory licence
>
> (1) At any time after the registration of an industrial design, any person may apply to the Court:
>
> (a) for the *revocation of the registration of the industrial design on the*

ground, subject to s 12, *that the industrial design has been disclosed to the public prior to the priority date of the application for registration of the industrial design*;

(b) ...

(c) ...

(Emphasis added.)

[14] The defendant's application for revocation is premised on s 12 of the IDA 1996. Under s 12 of the IDA 1996, an industrial design is incapable of being registered if it is not new. An industrial design is not new, according to sub-s 12(2) of the IDA 1996 if it has been disclosed to the public anywhere in Malaysia. Section 12 of the IDA states as follows:

(1) Subject to this Act, an industrial design *shall not be registered unless it is new*.

(2) An industrial design for which an application for registration is madeshall not be considered to be new if, before the priority date of that application, it or an industrial design differing from it only in immaterial details or in features commonly used in the relevant trade:

(a) *was disclosed to the public anywhere in Malaysia; or*

(b) was the subject matter of another application for registration of an industrial design filed in Malaysia but having an earlier priority date made by a different applicant in so far as that subject matter was included in a registration granted on the basis of that other application. (Emphasis added.)

[15] As stated in s 12(2)(a) above, the test to determining if a design is new is by asking the question of *whether an identical design* or '*an industrial design differing from it only in immaterial details or in features commonly used in the relevant trade was disclosed to the public* anywhere in Malaysia' (see *Magicboo Beauty Sdn Bhd v Koh Chui Ngoh* [2013] 1 LNS 370).

[16] In *Three V Marketing Sdn Bhd v Heng Capital Industries (M) Sdn Bhd (The Registrar of Industrial Design, interested party)* [2010] 2 MLJ 807, Justice Azahar Mohamed (as His Lordship then was) held at p 814:

[20] Now there are two ways in which the requirements of s 12(2)(a) of the Act for 'disclosure to the public anywhere in Malaysia' are fulfilled and they are namely: *(i) by prior use of the design, by selling or displaying to the public an article to which the design has been applied*; and *(ii) by prior publication in documents*.

[21] I find it useful to reproduce the principles as summarised in *Russell-Clarke and Howe on Industrial Design* (7th Ed):

Prior publication of a design by prior use can be said to take place when the design has

been applied to articles, and those articles have been used in such a way that the design becomes disclosed to the public before the date of application for registration of the design in suit. It should be noted that it is sufficient if the design is used on any kind of article, and it need not be the same article, or even in the same category, as the article in respect of which the design is registered or sought to be registered.

In general there will be publication if articles to which the design is applied are manufactured, displayed or used in such a way that members of the public will or might see them. It is not necessary that the articles should been sold. Prior use thus means not use by the public, but use in public as opposed to use in private. (Emphasis added.)

[17] It is the defendant's case that the plaintiff's ID lacks novelty as the Alpha Fan was published and/or sold before the registration date of the Alpha Fan, on 10 September 2007. The defendants relied on exhs D7 ('ESH cash bill'), D6 ('price list'), B5 and D9 to show prior publication of the plaintiff's Alpha Fan before 10 September 2007.

[18] However, it is the plaintiff's submission that the defendants' reliance of exh D7 ('ESH cash bill) and exh D6 (price list) is clearly misplaced as these objections are not pleaded in the statement of defence. In para 17 of the statement of defence, the defendants sets out the particulars of objection, that is:

PARTICULARS OF OBJECTION

A. The design shown in the Industrial Design Registration No MY07–01270–0306 is *not new* at the time of the application for registering it and was *formerly advertised* in Malaysia and also overseas in respect thereof or other goods or different from such design in terms of non — essential items or in various forms that are commonly used in trade due to:

(i) advertisement through the sale of same or similar design in Malaysia before the year 2007; and

(ii) common general knowledge.

B. The design elements in Industrial Design Registration No MY07–01270–0306 does not fall under the interpretation of 'industrial design' in s 3(1) of the Industrial Design Act 1996.

The full particulars on the matter set out above will be adduced at trial.

[19] I am of the considered opinion that there is merit in the contention of the plaintiff that the defendants are bound by their pleading. In *Yew Wan Leong v Lai Kok Chye* [1990] 2 MLJ 152; [1990] 1 CLJ 330, the Supreme Court held that:

[2] The trial of a suit should be confined to pleas on which the parties are at variance.

[20] Therefore, the evidence on exh D7 ('ESH cash bill') and exh D6 ('price list') are not on advertisement, but amounts to disclosure to the public by way of sales in the market. Bearing in mind that the pleaded issue is on disclosure to the public by advertisement, I am of the considered opinion that both exhs D7 and D6 should be disregarded by this court. However, if this court is wrong on the findings above, I will proceed to consider the merits of the defendants' arguments.

D7 — ESH cash bill

[21] It is the submission of the defendants that the Alpha Fan was already in the Malaysian market before 10 September 2007 based on a copy of a receipt from ESH Electrical Sdn Bhd. The defendants further submit that the Alpha Fan has been disclosed to the public by way of a sale before the plaintiff applies for the registration of the industrial design. The said receipt was tendered through PW1, without the maker being called to testify. PW1 gave evidence that he has no knowledge of exh D7 as the plaintiff does not get copy of the sale invoice of the distributor.

[22] Even though the ESH cash bill has been admitted as an exhibit, the same was admitted on the understanding that the maker will be coming to court. But the maker did not come to court to testify and the defendant did not offer any reasonable explanation for not calling the witness from ESH Electrical Sdn Bhd. In fact DW1 gave evidence that exh D7 was given to his wife by a person named Jackie, who promised to assist them but had changed her mind about coming to court.

[23] As such, I agree with the submission of the plaintiff that in the absence of the maker, D7 cannot be admitted as evidence and DW1 testimony in relation to a document issued by a third party cannot be relied as well. Added to that, *the ESH receipt is unsigned and is actually a reprint, not the original receipt*, as the original customer was allegedly given to the customer. Therefore, being a reprint, the receipt amounts to secondary evidence (s 63 of the Evidence Act 1950 ('the EA 1950')) and is not admissible unless it falls within the statutory exceptions pursuant to s 65 of the EA 1950. Added to that, I also agree with the submission of the plaintiff that the receipts, being secondary evidence without the maker being called and without any reason why the maker was not secured as a witness, cannot be admitted under s 73A(1)(a) and (b) of the EA 1950.

[24] The fact that D7 was admitted was because of an understanding between the parties that the maker will be called to give evidence. In fact, exh D7 was tendered through PW1 based on the said understanding. In any event, despite its admission, the said D7 should not be considered by this court

as the same was wrongly admitted based on parties understanding that the maker will come to court during the defendants' case. Thus the defendants cannot rely on exh D7 as it is inadmissible and should be expunged as it does not comply with the EA 1950. In *KPM Khidmat Sdn Bhd v Tey Kim Suie* [1994] 2 MLJ 627; [1994] 3 CLJ 1, the Supreme Court held that:

> Thus, basically, *secondary evidence of the contents of a document is inadmissible*, until the non — production of the original is accounted for, so as to bring it within one or other of the cases provided for in the section ... In the present case, based on the evidence of the respondent which we have highlight above, *we are satisfied the respondent had not shown that the non — production of the record book has been satisfactorily accounted for so as to bring it within* s 65(1)(c) *of the Act*. The respondent also had led no evidence to suggest that non — availability of his record book was through no fault of his ... (Emphasis added.)

[25] On the issue of no challenge to the admissibility of the exhibit, the Supreme Court cited with approval the decision of Edgar Joseph Jr J (as he then was) in *Popular Industries Ltd v Eastern Garment Manufacturing Sdn Bhd* [1989] 3 MLJ 360. In *Popular Industries*, Justice Edgar Joseph Jr held as follows:

> The exceptions to the rule are also well established and specifically provided (see s 65(1) of the Evidence Act). Equally clearly, the burden of proving the existence of any circumstance bringing the case within any of these exceptions lies upon the party seeking to adduce secondary evidence of the contents of the document.
>
> In the present case, the plaintiffs made not the slightest attempt to discharge that burden, with the result that P76 which was alleged to be extracted from the books of accounts of the plaintiffs, which were never produced, was inadmissible in evidence. Similarly, the oral evidence of the accountant Mr So, which was based on P76, was also inadmissible for the same reason.
>
> It is true that counsel for the defendants did not object to the admissibility of P76 or the oral evidence thereon of the accountant Mr So. But, to quote Masodkar J in *Sanjay Cotton v Omprakash* AIR (1973) Bom 40 (fold) at p 43:
>
> > ... here what one finds is the learned counsel merely said that he has no objection to exhibit the documents ... if that be so, it is neither an admission as to the documents nor can be treated as an admission of the contents thereof.
>
> Moreover, *it is settled law that inadmissible evidence does not become admissible simply by reason of failure to object*. (Emphasis added.)

[26] Therefore, premised on ss 65 and 73A of the EA 1950, I agree with the plaintiff that D7 should not be accepted nor relied as evidence for the purpose of establishing the fact that there was a sale of the Alpha Fan by ESH Electrical Sdn Bhd on 11 August 2007, before the date of registration on 10 September 2007.

D6 — price list

[27] Exhibit D6 is the plaintiff's price list of its products for the year 2007. It is not in dispute that the price list includes the price for Alpha Fan and the E-Light Fan. PW1 also agreed that D6 is the plaintiff's commercial price list effective 1 January 2007. Therefore, premised on the price list, the defendants submit that the Alpha Fan must have been manufactured and ready for sale to the public. Further, the defendants submit that dealers would have requested to see the pictures on the models on the price list, and therefore 'it is unreasonable for the plaintiff to have not foreseen the fact that a third party who saw the price list would be curious with the outlook of the products before they make the order'.

[28] Under re-examination, PW1 said that it is common practise that the price list is prepared in advance and is circulated to the dealers every year, to take effect on the 1 January of each year. The price list is for ordering purposes, for the dealers to place their orders for the models and the quantity, at the listed dealers' price. But the issuance of the price list to include the model does not mean that the Alpha Fan is already manufactured and ready for sales. PW1 admitted that when D6 was issued, there was no sale of the Alpha Fan as that relevant time.

[29] On its own, I am not prepare to accept that D6 is proof that there was sales of the Alpha Fan to the public before 10 September 2007. The defendants relied on the evidence of PW1, but PW1 gave evidence that despite the inclusion of the Alpha Fan in the price list, the Alpha Fan was not sold at that relevant time.

B5 — picture of Alpha Fan published in the magazine

[30] It is the defendants' contention, through DW2, that a picture of the Alpha Fan model E-light has been published in a magazine in February 2007 and on July 2007.

[31] On this advertisement, I agree with the submission of the plaintiff that the defendants have failed to plead any material facts pertaining to the alleged disclosure by way of advertisement. As such, the defendants cannot rely on the said advertisement to elicit disclosure prior to the date of registration, 10 September 2007.

[32] In any event, even if we are to consider the said advertisement, the evidence does not disclose the fact that the Alpha Fan has been disclosed to the public before 10 September 2007. DW2 cannot confirm that the fan in the pictures is the Alpha Fan. DW2 has also failed to produce any document to show that it is a picture of an Alpha Fan. DW2 also agreed that the pictures are of the E-Light Fan not the Alpha Fan. Further, the photographer who took the

picture of the alleged round shape fan was also not called to give evidence, leaving us with only the opinion of DW2, who thinks that it was an Alpha Fan.

D9 — letter of completion by fix

[33] Exhibit D9 is a letter dated 15 July 2007 for delivery for vacant possession. On its own, this letter has nothing to do with the Alpha Fan. However, the defendants submit that the purpose of this letter is to show a house renovation project completed by DW3's company using the Alpha Fan, and that the same project was published in the Creative Home Magazine. But the publication in the Creative Home Magazine was only made in October 2007 and as can be seen from p 3 of D8, the picture of a round shape fan has only been created on 24 September 2007. Therefore, it cannot be said that there was public disclosure before the registration of the Alpha Fan on 10 September 2007.

[34] In any event, DW3 did not personally know that the fan was an Alpha Fan because the purchase was made by the house owner, Wesley and installed by a worker. Both did not come to court to give evidence.

[35] Premised on my reasons above, I am of the considered opinion that the defendants have failed to establish that the plaintiff's ID lacks novelty because it was published and/or sold before the registration date of the ID, on 10 September 2007. The defendants' counterclaim on novelty is based on inadmissible evidence, hearsay evidence and mere opinions of the witnesses.

[36] It is also the defendant's pleaded case that the plaintiff's Alpha Fan has features that are commonly used in the relevant trade, such as the plaintiff's E-Light fan. However, from the numerous pictures shown by the defendants, it is not very clear that the fans have the round shape of the Alpha Fan.

[37] Added to that, the defendant's reliance on the E-Light design is misplaced as the bottom part of the housing of the E-Light fan is flat, not round, as it has a light at the bottom of the housing. On the defendant's submission that the design of the E-Light is not registrable as it lacks novelty, I agree with the plaintiff that the E-Light is not the subject matter of this application for revocation. Added to that, the defendants' submission on similar fact evidence is not relevant as the flat bottom of the E-Light is different from the round bottom of the housing of the Alpha Fan.

[38] In the premise, I find no merit in the defendants' application for the revocation of the registration of the plaintiff's Alpha Fan.

Issue on infringement

[39] The plaintiff's claim against the defendant is for infringement of its registered Alpha Fans pursuant to s 32 of the IDA 1996, which reads:

> 32 Infringement of registered industrial design
>
> (1) Subject to the provisions of this Act, the owner of the registered industrial design shall have the exclusive right to make or import for sale or hire, or for use for the purposes of any trade or business, or to sell, hire or to offer or expose for sale or hire, any article to which the registered industrial design has been applied.
>
> (2) Subject to section 30, a person infringes the rights conferred by the registration of an industrial design if he, without the licence or consent of the owner of the industrial design, does any of the following things while the registration is still in force:
>
> (a) applies the industrial design or any fraudulent ir obvious imitation of it to any article in respect of which the industrial design is registered;
>
> (b) import into Malaysia for sale, or for use for the purpose of any trade or business, any article to which the industrial design or any fraudulent or obvious imitation of it has been applied outside Malaysia without licence or consent of the owner; or
>
> (c) sells or offers or keeps for sale, or hires, or offers or keeps for hire, any of the articles described in paragraphs (a) and(b).

[40] For the purpose of s 32 of the IDA 1996, the plaintiff must prove on the balance of probabilities, the following facts:

(a) that the plaintiff is the registered owner of the industrial design; and

(b) that the defendants must have imported into Malaysia, trade, offer for sale and keep any article that is obvious imitation and/or applies the industrial design of the plaintiff's Alpha Fan.

[41] In *F&N Dairies (Malaysia) Sdn Bhd v Tropicana Products, Inc* [2013] MLJU 159; [2013] 1 LNS 380, the Court of Appeal held that:

> In order to succeed in its infringement claims under s 32(1) and (2) of the IDA 1996, the first thing that needs to be ascertained is that the respondent, who is the plaintiff in the actions, must be the owner of a valid registered industrial design, or a person who became entitled by assignment or transmission or through other operation of law to a valid registered industrial design as stipulated under s 30 of the same Act. The right to sue for infringement only relates to a registered design ie an industrial design which has been duly and validly registered under s12 of the Act.

[42] From the registration certificate, the Certificate of Industrial Design Registration No MY 07–01270–0306 clearly states that the plaintiff is the registered owner of the Alpha Fan. Therefore, pursuant to sub-ss 9(1) read with 9(3) of the IDA 1996, a copy of the certificate constitutes prima facie evidence that the plaintiff is the owner of the registered industrial design, the Alpha Fan. The defendants have failed to rebut this prima facie evidence that the plaintiff is the registered owner of the registered industrial design, the Alpha Fan.

[43] The next issue is for the plaintiff to prove that the defendants have traded, offer for sale and keep any article 'ASTA 56', which is an obvious imitation and/or applies the industrial design of the plaintiff's Alpha Fan. It is not in dispute that defendants have traded, offer for sale and keep any article 'ASTA 56' (see agreed fact 5). The only issue here is whether the 'ASTA 56' is an obvious imitation and/or applies the industrial design of the plaintiff's Alpha Fan.

[44] In making the comparison between the Alpha Fan and ASTA 56, guidelines can be found in the *Fe&N Dairies (Malaysia) Sdn Bhd* case, where the Court of Appeal held that:

> In order to ascertain what the registered design is, so that maybe it may be compared with the alleged infringement, *it is necessary to examine the representation of the design on the register. A copy of this is in practise attached to the certificate of registration. An actual manufactured article embodying the design may also be looked* at to assist the process of comparison, although if this course is adopted, care should be taken to avoid introducing further features which are not present on the representation on the register. (Emphasis added.)

[45] In the present case, the plaintiff submits that the design of the plaintiff's Alpha Fan can be examined and observed from the representation attached to the certificate of registration, the actual photograph and the actual manufactured Alpha Fan (exh P1(a) and (b)).

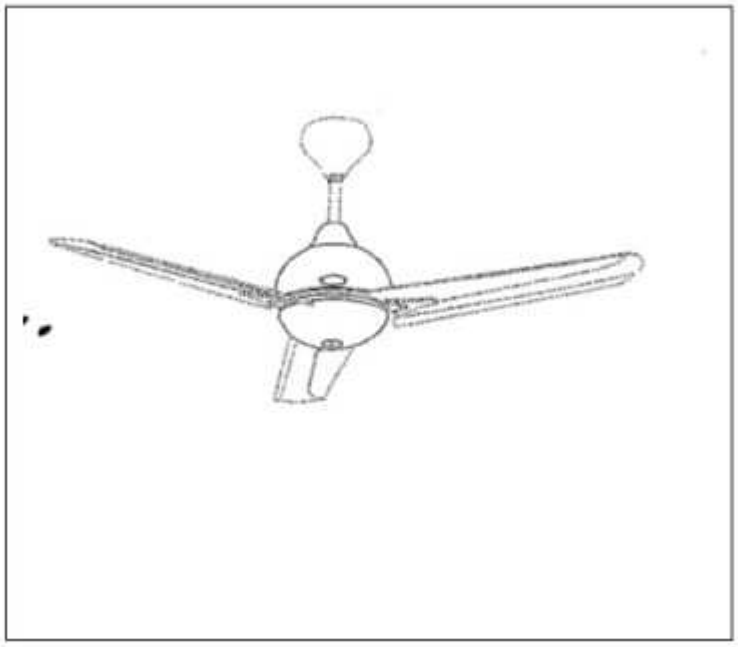
[46] The plaintiff also submits that the novelty statement, 'The novelty of the design resides in the shape and configuration of the article as shown in the solid lines in the registration' was meant to protect the shape of the Alpha Fan where the novelty of the design resides in the shape and configuration of the housing of the Alpha Fan which comprised of three parts:

(a) the FIRST PART is the bottom part of the housing designed in ROUND shape;

(b) the SECOND PART is the motor housing covering the motor, metal arms which hold the blades and motor of the fan which is design in ROUND shape; and

(c) the THIRD PART is the housing covering the downrod of a fan which is designed in CURVED CONE.

[47] Thus, the plaintiff's Alpha Fan is a 'round ball shape', and is neither an oval nor semi round shape with downlight, as can be seen below:



[48] With regards to the 'ASTA 56', the defendants evidence in Q7 and Q8 of WSDW1 is as follows:

> ... In terms of the canopy, NSB model 'ASTA 56' has a curved on the canopy whereas the Alpha's fan does not have the curve on its canopy. Further, NSB Fan 'ASTA 56' has a step down then curve towards the end whereas Alpha fans canopy has the shape of an upside down onion (see Q&A 7 WSDW1)
>
> Yes, apart from the abovementioned, the sizes between the two fans are dissimilar in terms of height and width.
>
> ASTA motor housing can be divided into four parts, from top to bottom (1) the coupling cover (2) the upper motor housing (3) the lower housing (4) the sensor cover.
>
> ASTA coupling cover has the shape of an upside down cup, having a wider bottom and a smaller diameter top.

The upper part of the motor housing has a small coupling cover which has a smaller diameter on top and wider diameter at the bottom of the coupling cover. The upper portion of the motor housing has a flat top with 18 oval holes at the edge of the flat surface.

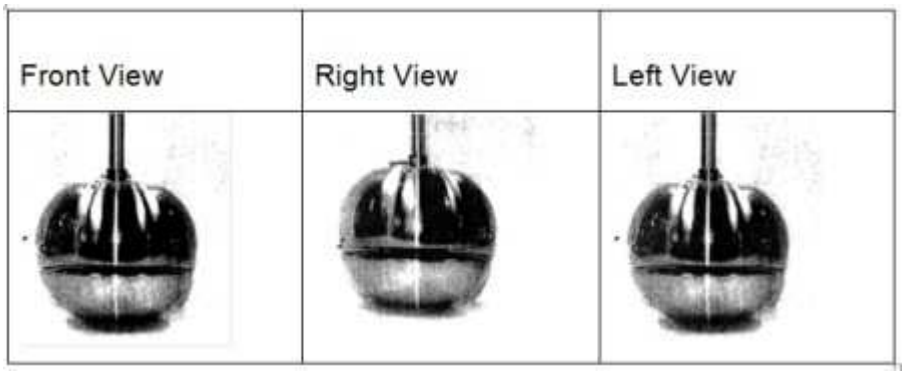
For the lower motor housing, at the centre of the lower motor housing, you will *see a shallow concave* and in the centre of the concave there is a red convex to cover the receiver sensor.

The top portion of the fan is flat and the coupling cover is small with a wider diameter bottom and smaller diameter at top. The air space are different as well. 'ASTA 56' has 18 holes whereas Alpha fans have 12 holes. The pattern of blades are different as well. Further to that, 'ASTA 56' has wireless infrared transmitter which is located in the centre of the fans' hub (see Q&A 8 WSDW1).

[49] With regards to the issue of infringement, the plaintiff's witness gave the following evidence in Q&A 16:

... The feature of shape, configuration, pattern and ornament applied of the housing of the NSB Fan model 'ASTA 56' is identical if not an obvious imitation of those corresponding features as set out in the plaintiff's Industrial Design Registration No MY07–01270–0306 in particular to first and second part of the Alpha Fan's Housing. The NSB model 'ASTA 56' is ROUND IN SHAPE, the infringement by the defendant is against the Housing of the Alpha Fan ...

[50] The alleged infringement is against the first and second part of the Alpha Fan's Housing, which are as follows:



[51] In order to make the comparison, I stand guided by the case of *Three V marketing Sdn Bhd* , where the learned trial judge referred to *Russell-Clarke and Howe on Industrial Designs* (7th Ed) and held that:

(28) A useful summary from *Russell-Clarke and Howe on Industrial Designs* (7th Ed) paras 3–152 read as follows:

The *question which has to be decided is whether the two appearances are substantially the same or not. That the eye, and the eye alone, is to be the judge of identity*, and is to

A decide whether one design is or is not an anticipation of another, has been consistently laid down. *The design must be looked at as a whole*, the question being whether an article made according to the design under consideration is substantially similar in appearance to an article made according to the alleged anticipation. *The test is not only to look at the two design side by side, but also apart, and a little distance away*. The novelty should in other words be substantial ... (Emphasis added.)

B

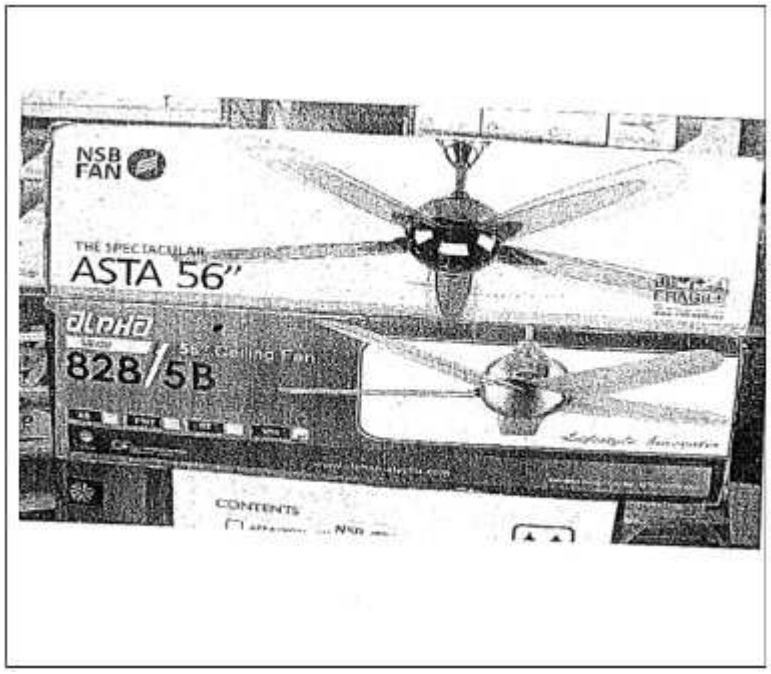
[52] Having considered and seen the Alpha Fan and the ASTA 56 as a whole, as presented in evidence before this court and from the pictures at pp 22–26 of Bundle B (for Alpha Fan) and pp 85–88 of Bundle B (for ASTA 56), I am of the considered opinion that both fans are round in shape, in respect of the bottom part of the housing and the motor housing (covering the motor, metal arms which hold the blades and motor of the fan).

C

D **[53]** However, it is the submission of the defendants that although the ASTA 56 fan is round, it is concave at the bottom. But viewing it from a little distance away, I find that the 'concave bottom' is neither noticeable nor distinctive enough to distinguish it from the plaintiff's Alpha Fan.

E **[54]** This can also be seen from the packaging of both fans at para (5) of the written submission of the defendants:

F



G

H

I

[55] Having seen the actual Alpha Fan and the ASTA 56, and having looked at the designs of both fans as a whole, I find that the shape, configuration, pattern and ornament of the defendants' 'ASTA 56' is an obvious imitation of the corresponding features to the Alpha Fan. In the premise, the plaintiff's claim is allowed and the defendants counterclaim is dismissed with costs.

Claim allowed and counterclaim dismissed.

Reported by Ashok Kumar